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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,917	01/22/2001	David E. Fenton	81869THC	1251

7590 11/06/2003

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EXAMINER

FISHER, MICHAEL J

ART UNIT	PAPER NUMBER
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3629

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DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,917

Applicant(s)

FENTON ET AL.

Examiner

Michael J Fisher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: The term "APS" is not described. While it appears to be a conventional film, it would appear that the film size and/or format is not necessarily standardized, as in the case of such films as 35mm or 110 cartridge film.

Appropriate correction is required.

Claim 11 is objected to because of the following informalities: The term "APS" is not described. While it appears to be a conventional film, it would appear that the film size and/or format is not necessarily standardized, as in the case of such films as 35mm or 110 cartridge film. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There is no technological step involved in the claims. There is merely recitation of a series of steps that could be taken merely mentally or at most with hand written receipts. The only manipulation, in section b) of claim 1, is not what is being claimed, as can be ascertained from the preamble of the claim. The claim is directed toward providing services and not taking pictures.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Smart et al. (Smart).

Smart discloses a system that includes selling a film product to a customer (as would be inherent in that the system discusses a customer using a one-time-use camera, col 4, lines 63-64, and further discusses that the system could be used for other types of film, col 5, lines 19-20), the customer partially exposes the film (in the reference this is the result of a defect, col 3, lines 13-16), and returns it for developing (claim 6), and providing compensation for unexposed units (claim 1, lines 9 and 10).

As to claims 2 and 3, Smart discusses the product as being a roll of film or a one-time-use camera (col 5, lines 17-20).

As to claim 11, Smart further discusses the film as being Advanced Photo System (APS) (col 5, lines 26-28).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smart.

Smart discloses a system as discussed above. Smart does not, however, teach the exact form of compensation, when the credit is provided or the provider of the service and user of the system.

As to claims 4-10 and 14, Smart does not specifically discuss the exact form of compensation, however, it is well known for providers of services to provide compensation in the form of services rendered instead of in direct cash refunds.

As to claim 12, it is well known for special events vendors to provide one-time-use cameras and further, to provide developing. Such places as amusement parks

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specifically have vendors selling cameras and/or film and providing one-hour developing to the patrons of the parks.

As to claim 13, it would appear inherent that Smart provides the credit with the return of the successfully exposed film pictures as opposed to either before the film is developed or at some point afterward. This would appear to either entail precognition in one instance or in unnecessarily aggravating a customer by not providing a credit until long after the completion of the transaction.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US PAT 5,372,386 to Mills, Mills discloses a method of crediting a user for unused portions of products purchased, US News and World Report article "Broken? No Problem (companies live up to warranty claims) (Broken), Broken discloses companies, such as providing refunds, replacements or credits to users of defective merchandise.

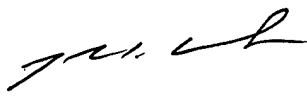
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Fisher whose telephone number is 703-306-5993. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

MF 
10/30/03


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600